

ESTTA Tracking number: **ESTTA1176846**

Filing date: **12/06/2021**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	90002764
Applicant	Jeanette Conrad-Ellis
Applied for Mark	THE BLACK DIAMOND SERIES
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Submission	APPLICANT'S MOTION TO CLARIFY THE RECORD REGARDING THE STATUS OF ADDITIONAL EVIDENCE
Attachments	90002764-Motion_re_Status_of_Additional_Evidence.pdf(250146 bytes)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re application of: :
Jeanette Conrad-Ellis :
 :
Serial No.: 90002764 : Examining Attorney: Sanjeev K. Vohra
 :
Filed: June 15, 2020 : Law Office: 110
 :
Mark: THE BLACK DIAMOND SERIES :

**APPLICANT’S MOTION TO CLARIFY THE RECORD REGARDING THE STATUS
OF ADDITIONAL EVIDENCE**

Jeanette Conrad-Ellis (“applicant”) hereby moves to have the record clarified as to the status of certain additional evidence, as outlined below.

On October 19, 2021, applicant filed Applicant’s Motion to Suspend the Appeal and to Remand for Additional Evidence (“Motion to Remand”). *Req. for Remand*, 9 TTABVUE¹. This Motion to Remand requested suspension of the appeal and remand to the examining attorney for the sole purpose of supplementing the record by the addition of federal trademark registrations of numerous color marks (“Additional Evidence”), the Additional Evidence being filed with the Motion to Remand as Exhibit 1, with the same Exhibit 1 having already been filed with Applicant’s Appeal Brief. *See Appeal Br.*, 6 TTABVUE, Ex. 1.

On October 25, 2021, the Trademark Trial and Appeal Board (“Board”) issued a response (“Board Remand”) to applicant’s Motion to Remand, stating that “Good cause having been shown, the request for remand is granted, action on the appeal is suspended, and the file is remanded to the Trademark Examining Attorney for consideration.” *Juris. Restored/Remand to Exam’r*, 11 TTABVUE 1.

On November 19, 2021, the examining attorney issued a denial (“Denial”) maintaining

¹ The citations to the T.T.A.B. record are to the documents in .pdf format.

and continuing the Section 2(d) Refusal of October 28, 2020 with regard to U.S. Reg. No. 1752451. *See Recon. Denied.*, 13 TTABVUE 1-2. However, the Denial fails to admit the Additional Evidence into the record in light of the Board Remand for good cause, or even indicate the examining attorney's position regarding the Additional Evidence.² Applicant is unaware of any proper basis for the examining attorney to avoid admitting the Additional Evidence into the record. *See In Re the Gov't of the D.C.*, 101 U.S.P.Q.2d 1588, 1591, 2012 WL 423804, at *2 (T.T.A.B. 2012) ("Once the Board granted applicant's request and remanded the file to the examining attorney for consideration of this evidence, the three third-party registrations which were the subject of the remand request became part of the record"). However, because of the examining attorney's failure to address the Additional Evidence, the record is not clear as to whether the Additional Evidence has been entered.

Accordingly, applicant hereby requests a finding by the Board that the Additional Evidence has been entered into the record. In support of its motion, applicant notes that it has good cause for filing its motion at this time (e.g., before the requested Oral Hearing has commenced, and likewise before any Board decision has issued) and that the examining attorney never timely objected to the motion for remand or the Board's Order granting the remand. *See Req. for Oral Hr'g*, 12 TTABVUE 2.

Basis for Applicant's Motion

In accordance with TBMP §§ 1207.02, 1208.02 and 1209.04, as well as 37 CFR § 2.142(d), applicant satisfies all requirements for the Board to grant applicant's motion to confirm the Additional Evidence is in the record. Specifically, applicant's motion is timely

² The examining attorney communicated to applicant on December 3, 2021 that he does not consent to entry of the Additional Evidence into the record. However, the topics discussed in this motion (e.g., whether or not the examining attorney properly addressed the Board Remand and/or the Additional Evidence, and the status of the Additional Evidence) remain at issue.

because it was filed before the Board's decision. *See* TBMP §§ 1207.02 and 1209.04. Applicant has demonstrated good cause for filing its motion and no proper objection has been timely made by the examining attorney.

Relevance and Purpose of the Additional Evidence and the Board Remand

The sole issue before the Board is whether applicant's mark THE BLACK DIAMOND SERIES for "a series of fiction books for teen girls, excluding cartoon science fiction books and comic books" may properly be refused registration on the basis of likelihood of confusion with the cited mark THE BLACK DIAMOND EFFECT (U.S. Reg. No. 1752451) for "cartoon science fiction books and comic books". Applicant previously submitted the Additional Evidence (e.g., third-party registrations) *only* as evidence of the fact that the registrations issued to demonstrate that the public is accustomed to seeing the same color-formative marks used with respect to very different publications. *See Appeal Br.*, 6 TTABVUE 7-10; *Req. for Remand*, 9 TTABVUE 3-4.

To the extent an examining attorney disagrees with the Board's remand order for the introduction of evidence, the examining attorney should promptly inform the Board of the objection to the remand. *See In Re Monster Cable Prod., Inc.*, 2015 BL 444440, at *2-3, 2015 WL 9702629, at *2-3 (T.T.A.B. 2015). The Board may then consider the examining attorney's objection, and may vacate (or not) the grant of the request for remand based on the examining attorney's objection to the Board Order. *Id.* Here, the examining attorney's Denial made no such objection to the Board Remand, and simply renewed his refusal without referencing the Additional Evidence. Thus, because the Board granted applicant's request to remand the file to the examining attorney for consideration of the Additional Evidence, and because the Examiner renewed its refusal without objecting to the Board Remand, the Additional Evidence became part

of the record.

Applicant contends that the Additional Evidence is of record by virtue of the Board's Remand order, but the examining attorney is attempting to thwart this outcome by refusing to confirm the admission of the Additional Evidence. Entry of the Additional Evidence is entirely proper at least for the reasons set forth in applicant's papers (e.g., briefs) of record and the Board's finding of good cause. *See In Re Javelin Cap. Markets, LLC*, 2015 BL 226320, at *2, 2015 WL 4380981, at *2 (T.T.A.B. 2015).

Applicant expressly requests that the Board confirm that the Additional Evidence is admitted and of record in this matter.

CONCLUSION

For the above reasons, applicant hereby respectfully request that the Board grant applicant's motion to confirm the admission of the Additional Evidence into the record.

Dated: December 6, 2021

Respectfully submitted,

/s/ Edward W. Gray, Jr. _____

Edward W. Gray, Jr.

Shoko Naruo

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing APPLICANT'S MOTION TO CLARIFY THE RECORD REGARDING THE STATUS OF ADDITIONAL EVIDENCE was sent via electronic mail on December 6, 2021 to the following:

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